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In the United States Patent and Trademark Office

William E. McLaughlin

10/015,798 filed 11/02/01

Art Group 2878, Asst. Ex. Otilia Gabor

Southampton, PA 18966-4545

May 29, 2003

Commissioner of Patents

Alexandria VA 22313-4350 via FAX 703-398-3393

Request for Interview on June 16, 2003

I have had many interviews in my 66 years as a lawyer prosecuting patents. Never before has there been a situation that seemed to require as much top-level participation by the Patent Office as in the present situation. In the CIP of the parent application, the Examiner made an extremely unreasonable restriction requirement at a very belated stage of the prosecution, and then repeated the restriction requirement after an extremely persuasive explanation of why the restriction requirement was inappropriate for an application filed in 1999. I do not presently recall just how many Actions were prepared by the Examiner in the parent case, which should have been governed by the restriction requirements applicable when the case was filed on Jan. 21 1999. The method and apparatus claims should have issued in the same patent. Moreover, the Examiner repeated the unreasonable restriction requirement after persuasive arguments. My expert opinion concerning the futility of appeals to the Commissioner concerning technical issues prompted the strategy of capitulating to the unreasonable restriction requirement. I treated the necessity for duplicate issue and maintenance fees as wiser strategy than risking delays through an appeal to the Commissioner concerning the unreasonableness of the restriction requirement. (B3)

FAX RECEIVED

MAY 29 2003

TECHNOLOGY CENTER 2800

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Proofreading errors are sometimes not detected promptly. It has been rumored that it was a clerk for a Supreme Court Justice who discovered that dozens of lawyers and judges had overlooked the status of a particular document because many readers saw what they expected to see. A somewhat similar situation occurred in the McLaughlin case.

The Examiner and I both intended to issue the method claims and to have the apparatus claims in the divisional case. This is that divisional case.

I have long had proofreading problems. The Examiner herein is to be commended to discovering that in one document I allowed a paper to be filed with an inaccurate attorney registration number, one of the rarest typographical errors with which the Patent Office deals.

I was horrendously embarrassed when, several days after the issuance of 6,482,108, I discovered that the patent had issued with the article claims instead of the mutually intended method claims. What amazed me was that Richard Jenkins, Chief Technology Officer of LIRSI, assignee of the invention, and who has had more than 40 years experience as an expert concerning patent licensing, also failed to note the goof by the Patent Office until I pointed it out to him.

My initial reaction was that this inadvertent error was traceable exclusively to the Patent Office. It was only when I had my Washington Associate, Eric Scherlin, investigate that I discovered that both the Examiner and I had been victims of proof-reading errors analogous to the Ewbank-Jenkins proof-reading errors after issuance of 6,482,108.

Most individuals recognize colors, and can only imagine what are the problems of individuals who are color blind. Similarly an individual who has almost never tolerated a proof-reading error has problems in coping with the difficulties of those prone to typographical errors. Congress would not have authorized the Commissioner to cancel a patent if there had not been

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recognition that inadvertent errors can be made by the Patent Office that are appropriately dealt with by the cancellation of the patent. The Inventor and LIRSI continue to assert that their property rights in the invention are quite valuable, and cannot be the sole cause for cancellation of 6,452,108, but they could welcome the wisdom of the Commissioner in recognizing the appropriateness of such option. I am open to alternative strategies, but deem an interview with decision makers is appropriate.

I have never sought a Certificate of Correction herein, and still do not deem that approach appropriate. This is an extremely valuable invention, for which applicant is entitled to plausible patent protection. If there were litigation on 6,482,108, the defendants could attack the validity of the apparatus claims. This creates an overall situation in which some correction seems appropriate, but just what it should be done requires top level decision-making within the Patent Office.

Some of these issues were made of record herein. In my 66 years of patent prosecution, I do not recall any Office Action as remarkably thorough as the commendable rejection of April 30, 2003 rejecting all claims without reference to 6,392,108. Obviously one of the relatively easy way for the Patent Office to deal with this embarrassing problem would be to deny LIRSI any patent protection whatsoever by rejecting the present application.

I have planned to file an additional application soon, but I wanted to wait until the problems relating to the 1999 application were clarified. Such additional application is likely to be a continuation in part application asserting the benefit of the 1999 application. However, because of the absence of pertinent intervening art, the eventual royalty income could probably be several million dollars more if I were to assume the risks of not seeking such priority. The Patent Office should recognize that such potentiality of ignoring nearly five years of evolution in a realm in which there has been about a

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billion dollars of research during those five years is remarkably persuasive proof of the unobviousness of the present invention. Previously I had assumed that it would be essential to set forth in the application the priority of such 1999 application.. I deem it most remarkable that a technical advance as spectacular as here involved has not had ANY known pertinent references in the nearly five years since filing. For a pioneer invention, that is remarkable persuasive evidence of non-obviousness. All three owners of LIRSI are in their 80s, but treat LIRSI as a potential source of significant income as soon as the patent problems are under control. Hence, some consideration has been given to the potentiality of filing the additional application prior to Oct. 18, 2003 without seeking the priority of the application leading to 6,842,108. The cost for an adequate search prompts plans for the continuation inn part application.

I have been and am working on an amcndment, and expect to file one by FAX prior to the requested interview. Because it is hoped that the interview can lead to the simplified strategy of promptly filing the contemplated continuation-in-part application the early abandonment of this application and the Commissioner's cancellation of 6,452.108 should pave the way toward a more plausible prosecution for the contemplated continuation in part application..

If June 16 is not suitable, some later date should be suggested when these extremely troublesome [both for the Patent Office and for LIRSI] problems can be dealt with. I will be travelling for more than a week between now and then. Hence, your promptness in responding to this request would be much appreciated.

Respectfully submitted, *John R Ewbank*
John R. Ewbank, Reg. # 14,853

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PTOL 415A (12-02)
U.S. Patent and Trademark Office U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form

Application No: 10/015798 First Named Applicant: W. McLAUGHLIN
 Examiner: CILIA GABOR Art Unit: 287.3 Status of Application: first rejection
closely approaching
5 year SPE (AI)
status

Tentative Participants:
 (1) John R. Eubank (2) _____
 (3) _____ (4) _____

Proposed Date of Interview: Mon JUNE 16 Proposed Time: 3:00 PM (M/MTM)

Type of Interview Requested:
 (1) ☐ Telephonic (2) ☒ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: YES (1) NO
 If yes, provide brief description: APPARATUS CLARIFYING INVENTION

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>COUNSEL DEEMS SITUATION</u>			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) <u>ALMOST UNPRECEDENTED</u>			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) <u>AND REQUIRES TOP LEVEL</u>			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) <u>DECISION MAKERS OF PATENT OFFICE</u>			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Continuation Sheet Attached

Brief Description of Arguments to be Presented:

An interview was conducted on the above-identified application on _____

NOTE:
 This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).
 This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

John R. Eubank
 (Applicant/Applicant's Representative Signature)

 (Examiner/SPE Signature)

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EPM TC 2800

FINAL SEARCH DATE _____

DELIVER TO GOVT DATE _____